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Supreme Court of the United States

OCTOBER TERM, 1941.

No. 237.

WILLIAM G. WHEAT, PETITIONER,

VS.

FORD MOTOR COMPANY, A CORPORATION,
RESPONDENT.

PETITIONER'S REPLY TO RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI.

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I.

The construction by the court of appeals of the patent herein, contrary to the law on the subject, is a matter of public interest—especially since the courts below have unsettled the law.

Respondent says:

> "A simple private controversy has been waged in nowise of public interest, *and no unsettled question of law involved.*"

Since this is an inventive nation devoted by its Constitution "To the progress of science and the useful arts" (Art. I, Sec. 8, Clause 8), and since petitioner has been deprived of his patent rights secured by an act of Congress by the deliberate act of respondent, it is certainly a matter of public interest whether the constitutional purpose shall be frustrated by said deliberate act with the approval of two national courts by the application of *unauthorized rules of construction* to a patent and by a denial of a review by this court. In any event, respondent has overlooked the consideration that ours is a "Government by lawsuit" (see "The Struggle for Judicial Supremacy," Jackson 286, 310) and that whenever the government functions, the public is interested.

What follows demonstrates that the rule applied by the circuit court of appeals in its "narrow" or "strict" construction (or shall we say rewriting) of the patent unsettles the *liberal* rule heretofore observed, so that there is a question "of public interest" and an "unsettled question of law involved" herein.

The patent (Tr. p. 293) recites:

> "It is manifest that with a car '*constructed*' in this manner, the chassis will be brought closer to the ground similar to the well-known underslung arrangement, and when applied on Ford cars will have a tendency to hold the car to the ground when traveling at high speed."

That language contemplates *original construction* embodying the patent, at least in the part before the comma. It would seem to authorize its use also on already constructed cars in the language after the comma.

The rule of construction adopted by the court of appeals was one by which it excluded the word "constructed" from the patent and interpolated the word "reconstructed" therein. Only thus could it arrive at the conclusion that the accused structure did not infringe. But this court

has pointed out that (*Rubber Co.* v. *Goodyear*, 9 Wall. 788):

> "A patent should be construed in a *liberal spirit* to sustain the just claim of the inventor. This principle is not to be carried so far as to *exclude what is in it* or to *interpolate anything* which it does not contain. But *liberality*, rather than strictness, should prevail where the fate of the patent is involved, and the question to be decided is whether the inventor shall hold the fruits of his genius, and his labors."

The rule applied by the court of appeals was diametrically contrary to the above and to that observed by other circuits (*Jabers Manville Co.* v. *National Tank Seat Co.*, 49 F. 2d 142; *Sun Ray Gas Corp.* v. *Bellows-Claude Neon Co.*, 49 F. 2d 886) and to other decisions of this court (*Turrill* v. *Ry.*, 1 Wall. 491; *Smith* v. *Snow*, 294 U. S. 1).

II.

This patent in suit expired on October 18th, 1938. Respondent is the only infringer. Its infringement was between 1932 and 1938. There never can be further litigation in another circuit involving this patent. Therefore, the rule in *Keller* v. *Adams et al.*, 264 U. S. 314, invoked by respondent does not apply.

The true rule in this sort of case has been well stated by the present chief justice in *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 305 U. S. 47, 83 L. Ed. 34, thus:

> "Petition for certiorari raising the question, among others, whether the court of appeals had erred in holding patentable a combination including one element not described in the original application for the Gulick patent and later added to it by amendment, and not described at all in the Mayard patent, *was at first denied, there being no conflict of decision.* 303 U. S. 639. We later granted certiorari in 304 U. S. 587, on a petition for rehearing, showing that notwithstanding the doubtful validity of the patent *litigation elsewhere with a resulting conflict of decision was*

improbable because of the concentration of the automobile industry in the sixth circuit."

The rule of the *Keller Case, supra,* invoked by respondent discriminates against inventors by closing the doors of this court to such persons. For a rule requiring persons of that humble class to litigate a controversy to final decision in one circuit in one way and to litigate over the same patent and to persuade a court of appeals of another circuit to render a conflicting decision concerning that same patent as a condition precedent to a remedy by certiorari in this court which condition is not imposed on other litigants is to discriminate against him and to deprive him of that equal protection which all others enjoy—contrary to the fundamental rule on that question well stated by Chief Justice Rugg in *Bogni* v. *Perrotti,* 224 Mass. 152, and by this court in *Green* v. *Biddle,* 8 Wheat. 75, and *Bronson* v. *Kenzie,* 1 How. 317. Indeed that rule if applied would render Section 347, Title 28, United States Code, void as a law authorizing the national courts to deprive an inventor of his property without due process because of the discrimination. Such a result would deprive this court of jurisdiction to grant a writ of certiorari in any case save those governed by Section 377, Title 28, United States Code Annotated.

III.

Respondent's suggestions that the proceedings in the Patent Office limited the claims is merely unfounded assertion which does not answer Reason XI, page 19 of the petition for certiorari, nor is it a justification of the act of the court of appeals in reading the introductory phrases of the claims into same as a limitation of the claims of the patent.

The introductory phrase in each claim, to-wit:

"An underslung attachment for motor vehicles"

was merely the title of the patent and no part of the combination described in each claim. No significance should have been given to the word "attachment." The word "device" or "contrivance" or some other such word would have been just as good. To read the title or introductory phrase into the claims was to render a decision in conflict with the decisions of other circuits (*Sly* v. *Russell & Co.*, 292 Fed. 851 (C. C. A. 6); *Nye Tool and Machine Works* v. *Crown Die and Tool Co.*, 292 Fed. 851 (C. C. A. 7)).

It was also in conflict with the statement of this court in *U. S.* v. *Société Anonyme et al.*, 224 U. S. l. c. 328, as follows:

> "It would indeed be arbitrary, as said by claimant, to read into the claim the specific metal of which these shells are composed, for no other purpose than to render it (the claims) worthless."

It was also in conflict with the rule of the Patent Office and the Court of Customs and Patent Appeals (see *In re Janell*, 120 F. 2d 1012, Syl. 1).

> "The preamble or introductory phrase of a patent claim may not be taken as a part of the subject matter of the claim."

The opinion says (l. c. 1014):

> "The solicitor for the Patent Office in this court cites a number of cases of this court to the effect that the preamble or introductory phrase of a claim may not be taken as a part of the subject matter of the claim. * * * The solicitor further argues that since the preamble may not be considered part of a claim, the limitation expressed in the preamble need not be considered, even though the application disclosure would support a patentable claim if it had been made and cites a number of cases including the famous 'wax nose' case—*White* v. *Dunbar*, 119 U. S. 47."

The reading of the preamble or introductory phrase into the claims by the court of appeals thus unsettled

another question of law which had been settled to the contrary by this court, by the other courts of appeal, by the Court of Customs and Patent Appeals and by the great executive or administrative agency charged with administering the patent laws of the country in the United States Patent Office itself.

Does it not necessarily follow that no more important questions of conflict in any patent case have ever been presented to this Honorable Court and hence that the writ should issue?

IV.

The claim that the prior art invalidated the patent is without merit for two reasons.

(1) The trial court refused respondent's suggested Findings of Fact 8, 9, and 11 (Tr. 14-15) and also Conclusions of Law 4, 5, and 6, thus deciding the issue as to "prior art of record" against respondent. Again Conclusion of Law 1 (Tr. 15) and Finding of Fact 10 to the effect that the claims of the patent in suit "alone survived" was a finding of validity (Tr. 15). These were issues tendered by respondent's pleading. The trial court decided those issues against respondent. Respondent did not appeal and cannot now be heard to question decisions from which it did not appeal (*Morley Construction Co.* v. *Maryland Casualty Co.*, 300 U. S. 185.

Respondent's expert Brush testified that his experience began "in connection with the manufacture of the first car that was produced in this country in quantities." That he was chief engineer for the Cadillac Company and was associated with many automobile companies; was consulting engineer for all the divisions of the General Motors Company until 1913, acted as consultant in engineering matters and for fifteen years gave expert testimony in patent litigation, having taken out about 100 patents in his own name (Tr. 227-228).

While Mr. Brush was on the witness stand respondent offered "copies of the prior art references which were set up in the answer" (Tr. 228) (Tr. 67).

He then testified:

"Q. Mr. Brush, have you examined the prior art patents and publications just introduced and offered in evidence?
A. Yes.
Q. And do you understand the contents of them?
A. Yes.
Q. And have you examined the accused's structure, the defendant's?
A. Yes.
Q. Now, will you please discuss the disclosure of the Wheat patent so far as it has any application to the defendant's construction, *making such reference to the prior art patents and publications as may be pertinent*" (Tr. 232).

On cross examination he testified as follows:

"A. * * * Now, if you mean what I mean by combination, that is to say the specific construction illustrated and defined in the claim, no, I never saw precisely that construction.
Q. Yes; you never did see anything of that kind, either in the old days or in the new, isn't that right?
A. That is right * * *.
Q. That is to say, you never did see in any publication, or in all of your experience, a construction of the kind that Mr. Wheat patented?
A. Well, that again—now pardon me, Your Honor, I am not attempting to interpret the claim—
Q. (interrupting) I mean by that the combination described in the patent.
The Court: It is a simple question. Did you ever see it in a publication? That is your question?
Mr. O'Donnell: That is right.
A. The specific combination, the specific construction, no. Structures that accomplish the same result, yes" (Tr. 251).

* * * * * * *

"Q. What are the advantages of the V-8 Ford over the Model T, if any?

A. Greater passenger comfort, higher speed, greater safety at speed, better appearance, greater durability, in general a more desirable car" (Tr. 252).

The above testimony and the last answer demonstrate that the incorporation of the patent in the V-8 Ford and Model T Ford had the same result.

The result of such incorporation is thus established by petitioner's uncontradicted testimony.

"Q. Now, after you had perfected your structure did you have your car at any race track?

A. I did.

Q. Where?

A. Independence, Missouri.

Q. And did you test it?

A. I did.

Q. And you may state whether or not your test showed any improvement over the car or cars.

A. There was a very peculiar situation arose when that car was driven. It was found in time to remove in competition two cars, of similar Fords, similar structure, that the motor and axle structure, that is the structure utilizing that principle shown by the exhibits there, was from three to five seconds faster.

Q. Your structure?

A. Yes, my structure was from three to five seconds faster on the half-mile loop.

Q. What else, what other features did it have?

A. Well, it had a tendency to cling to the turns much better than the other structures" (Tr. 102).

Mr. Brush's evidence demonstrated that there was no "prior art of record" to limit the scope of what Mr. Brush's evidence demonstrated was a pioneer patent.

For—

"The state of a particular art, at the time of a particular invention, includes whatever *inventions,*

belonging to that art, had already been *invented* and *used* in the United States, or described in any printed *publication* in any country" (Section 230, Walker on Patents, Sixth Edition, page 316).

The fact that defendant's learned expert never in all his experience had seen a structure, patent, or publication such as that covered by petitioner's patent established lack of anticipation and lack of prior art. He further stated that he saw "structures and accomplished the same result" (Tr. 251) and then testified to facts establishing that the V-8 Ford cars were structures which had the advantages of "higher speed" and "greater safety at speed" than the old Model T Ford. When the patent was embodied in the old Model T Ford cars it was discovered that those cars attained "higher speed" and "greater safety at speed" than before (Tr. 102).

Mr. Brush's evidence, therefore, as a matter of law destroyed the claims of anticipation, limitation of claims by prior art and conclusively established respondent's infringement of petitioner's patent. For that evidence corroborated that of petitioner and established that the embodiment of the patent in the Model T and V-8 Ford automobiles caused each to achieve the same results, perform the same functions, by the same means or mode of operation.

So that the rule well stated by Walker on Patents, Sixth Edition, Section 238, applies to respondent's evidence and requires the application of the rule stated by him after analyzing four leading cases: Thus

> "The meaning of these four cases seems to be that every inventor is entitled to claim whatever he was the first to invent. If A. B. (Wheat) is the first to invent mechanism to perform a particular work, and if his invention is substantially incorporated into subsequent machines which do that work, then A. B. (Wheat) is entitled to such a construction of his patent as will be infringed by those later machines."

Why does not that rule apply here?

> "The mere fact that the various elements of a combination are old will not anticipate a claim to the combination."
>
> *Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.*, 220 U. S. 428.
>
> 48 C. J. 31.

> "To find in the prior art each element in isolation is not to anticipate the work of an inventor who evolves a new combination of those elements which by their conjoined function produce a new result."
>
> 48 C. J. 31, citing *Parks* v. *Booth*, 102 U. S. 96; *Imahaeuser* v. *Burk*, 101 U. S. 607.

> "A combination is a union of elements, which may be partly old and partly new, or wholly old or wholly new. But whether new or old, the combination is a means—an invention—*distinct from them.*"
>
> *Leeds & Coblin Co.* v. *Victor Talking Machine Co.*, 213 U. S. 301.

V.

The Z-shaped bracket embodied in the accused structure by the equivalent thereof includes all of its parts so that no specified element of the patent is absent from the accused construction.

Respondent's brief says:

> "* * * the total absence from the accused construction of certain specified elements necessarily excludes that construction from the scope of the claims" (Resp. Br. p. 2).

The above is a mere assumption of absence "from the accused construction of certain specified elements." The claims in describing the "Z-shaped bracket" also mention its parts. Thus:

Claim 1—"The body portion of the bracket having an opening beneath the spring for the purpose specified."

Claim 2—"* * * an arm depending from the forward end of the bracket in parallelism with the body thereof, and a brace rod connecting the said arm and body and arranged transversely of the spring."

Claim 3—"* * * an arm depending from the forward end of the bracket and said arm and body portion of the bracket having a line crank receiving openings."

The court of appeals in describing the means specified in the patent claims referred to the bracket and its parts thus:

> "* * * to drop and fasten the front end of the frame upon a rearwardly extending arm of a substantially Z-shaped bracket, the upper or forwardly extending arm of which was mounted upon the front spring."

That is to say the finding as to the bracket included the above parts in it as a single element of the combination in accordance with the rule outlined in *Reed* v. *Edwards*, 101 F. 2d 550, that:

> "For patent purposes a given structure may in one sense be considered a single element and in another sense it may be so formed as to consist of several elements depending on the function to be performed by such elements."

Indeed the "depending arm" operated to make the "Z-shaped bracket" of the patent almost an exact duplicate of the sectional view of the Z-formed front cross member illustrated by the top or right photo thereof in Respondent's Exhibit 1 (Tr. 313) as admitted by respondent's counsel (Tr. 64).

Hence, the statement in the concluding paragraph of the opinion that

> "since the accused device * * * did not include elements essential to plaintiff's patented combination"

is not based on the record but on the gratuitous statement in respondent's briefs such as we find in its brief here. Respondent's evidence (Tr. 180-242) corroborated that of petitioner (Tr. 122-124) to the effect that the raised frame ends and Z-formed cross member was the equivalent of the Z-shaped bracket—that is the equivalent of the whole bracket, including its parts—and so since the whole element is equivalent to the accused element no element is absent.

VI.

The claim that petitioner has shifted the ground of his infringement contention is without foundation in the record and merely demonstrates how the lower courts were misled.

Respondent, on page 3 of its brief, says:

> "A further example of petitioner's misdirected effort is to be found in a shifting of ground for his infringement contention. At trial he went upon the proposition that an equivalent of his Z-shaped bracket was to be found in the upturned front end portions of the *side rails* or *sills* of respondent's chassis. Now he shifts from that position to an attempt at finding an equivalent in the *front cross member* of respondent's chassis.
>
> Thus petitioner would have this court issue a writ of certiorari for review on a different theory of infringement from that which will be found upon the record to have been advanced below—a singularity in conception of Supreme Court practice in patent jurisprudence, to say the least. 'He is not permitted thus to mend his hold' " (*Railway Co.* v. *McCarthy*, 96 U. S. 258, 267) (a personal injury case).

The record shows that the above statement has *no support in the record.* It is *directly contradicted by the record.* See petitioner's suggested Finding of Fact 3 (Tr. 11, 12). See also (Tr. 20, 122, 124, 94, 95) for petitioner's testimony.

"The spring is secured to the *front cross member*, which is the *same mechanical equivalent as the bracket* mentioned in the frame (Tr. 124).

The *cross member* acts in the same mechanical relation as the bracket" (Tr. 124).

On cross examination of petitioner by respondent's counsel, he was asked:

"Q. Now you are including as the Z-shaped bracket in this Ford V-8 construction then its *two side frame members* extending back about five feet and toward the center of the car, and also the cross main members, is that correct, *the front cross main member.*

A. Yes" (Tr. 122).

Respondent's only witnesses as to this point agree with petitioner (Tr. 180, 242). Hunt (Tr. 179-180) on testifying to anticipatory use of the patent bracket element on a race track in 1914 (Tr. 193), nine years before he built it in 1923 (Tr. 188), testified—

"We afterwards found it was much simpler merely to take out the *front* cross member in the Ford frame which extended downward *and raise the frame* and put in a *straight cross member* and get the *same distance lowering* as this with much less trouble" (Tr. 180).

Brush attributed the lowering in front, amongst other things, to a

"somewhat less deeply arched *cross* member" (Tr. 242).

so that not only did petitioner at the trial *testify* that the "turned-up front end portions of the *side rails or sills*" and "the *front cross member*" riveted thereto in the accused structure duplicated the Z-bracket but respondent's only witnesses on the question agreed with and corroborated petitioner on the point. This is further illustrated by cross examination of plaintiff by the same counsel who made the quoted statement. Thus:

> "Q. I would like to ask you whether or not it is your opinion that the *side frame members* of the Ford V-8 are the same thing as your Z-bracket?
>
> A. The *forward portion of the side frame member with its cross member* performs the same function" (Tr. 120).

Petitioner's petition herein expressly says (page 9):

> "* * * it was conclusively established by respondent's witness Hunt (Tr. 180) with the concurrence of petitioner (Tr. 82) that the *said raised frame and cross member* together accomplished the same distance lowering as the Z-bracket of the patent and constituted an equivalent thereof."

The above-quoted statement in respondent's brief directly contradicted as it is by the record furnishes *the only reason or excuse* for the *obiter* contradictory findings of the two lower courts. The decisions below were caused by acceptance of the "self-serving professions of those on trial," through their counsel and warrants the incredible implication that counsel for respondent knew whereof he spoke when he used the language quoted in *Parker Rust Co.* v. *Ford Motor Co.*, 23 F. 2d l. c. 506, that—

> "There is no power on earth, this side of the Supreme Court of the United States, which would make Henry Ford sign a license agreement or pay a royalty."

It is again respectfully urged that the writ prayed for issue.

Respectfully submitted,

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